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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KELAN C. SILVESTER

Appeal 2009-008169
Application 09/974,923
Technology Center 2400

Before KENNETH W. HAIRSTON, THOMAS S. HAHN, and
CARL W. WHITEHEAD, Jr., *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1 to 5 and 7 to 29. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

Appellant's invention relates to a security system which uses a method of disabling the operation of a wireless device when the wireless device fails to communicate with a base station over a range limited wireless protocol, such as Bluetooth (claim 1; Abstract; Fig. 1; Spec. 1:12-25).

Claims 1 is representative of the claimed invention and reads as follows:

1. A method comprising:

disabling an operation of a wireless device that fails to communicate with a base station over a range limited wireless protocol.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Cromer	US 6,166,688	Dec. 26, 2000
Girard	US 6,654,890 B1	Nov. 25, 2003

(i) The Examiner rejected claims 1, 2, 4, 7 to 9, 11, 12, 14, 16 to 18, 20, 21, 23, and 26 to 28 under 35 U.S.C. § 102(e) as anticipated by Cromer.

(ii) The Examiner rejected claims 3, 10, 13, 19, 22, and 29 under 35 U.S.C. § 103(a) based upon the teachings of Cromer and Girard.

(iii) The Examiner rejected claims 5, 15, 24, and 25 under 35 U.S.C. § 103(a) based upon the teachings of Cromer.

With regard to the anticipation rejection of claim 1, Appellant argues *inter alia* (App. Br. 10-11; Reply Br. 1-3), that Cromer teaches disabling in response to a failure to authenticate with a password, and not cutting off communication in response to a failure to communicate.

With regard to the obviousness rejection of claim 10, Appellant argues, *inter alia* (App. Br. 11-12; Reply Br. 3), that Cromer and Girard do not relate to claim 10 which requires authentication by a base station before the wireless device can boot.

Appellant also asserts (App. Br. 12; Reply Br. 3) that Girard is not available as a prior art reference under § 103(c).

Based on Appellant's arguments, the issues presented are:

- (i) Do the broadest reasonable interpretations of claims 1, 11, and 20 encompass Cromer's teaching of disabling the operation of a wireless device in response to a failure to authenticate?
- (ii) Is Girard available as a prior art reference?
- (iii) Does Cromer alone disclose or suggest sending a Bluetooth protocol signal, as set forth in claims 3, 13, and 22?
- (iv) Does Cromer alone disclose or suggest preventing a wireless device from booting if a signal is not authenticated by the base station, as set forth in claims 10, 19, and 29?

FINDINGS OF FACT (FF)

1. Cromer describes a method for disabling the operation of a wireless device such as portable computer 30 (PC) when a determination is

- made that the PC 30 is located outside of an authorized area (Abs.; col. 3, ll. 22-25; col. 4, ll. 13-16; col. 8, ll. 23-27; Figs. 1, 2, 3A, and 3B). The PC 30 is disabled by ceasing the supply of system power (step 348 in Fig. 3B). A privileged access password used to verify the identity of an authorized user of the PC 30, is received by power security unit 260, and is compared to a password stored in password storage 264, to determine whether or not to issue a power control signal 269 to power supply 240 to discontinue supplying system power 243 (col. 4, ll. 1-15; col. 5, ll. 18-65). A gate 20 uses a network 24, RF signals, wireless signals, or any other suitable method to communicate with server 22 (col. 4, ll. 34-42; col. 7, ll. 40-42), and gate 20 receives communications in the same manner from PC 30 (col. 7, ll. 32-39).
2. Cromer also describes a method for beginning a boot process (step 302) and then completing the boot process (step 326) only when a password has been correctly entered (steps 306, 308, and 318) (*see* Fig. 3A).

PRINCIPLES OF LAW

Claim Construction

“During examination, ‘claims ... are to be given their broadest reasonable interpretation consistent with the specification, and ... claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re Am. Acad. of Sci. Tech*

Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997).

Anticipation

Anticipation is established when a single prior art reference discloses, expressly or under the principles of inherency, each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Obviousness

Subsection (c)(1) of 35 U.S.C. § 103 dealing with conditions for patentability, states:

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103 (c)(1) (2004).

ANALYSIS

First Issue: Interpretation of Claims 1, 11, and 20

The broadest reasonable interpretation of claims 1, 11, and 20 encompasses Cromer's teaching of disabling the operation of a wireless device in response to a failure to authenticate.

Claim 1 recites "disabling an operation of a wireless device that fails to communicate with a base station over a range limited wireless protocol."

Thus, claim 1 merely requires a failure to communicate, which encompasses Cromer's teaching of authenticating a password, and of ceasing power supply for operation of a wireless device (i.e., PC 30) upon failure to authenticate (i.e., an incorrect password) (*see* FF 1). In other words, we agree with the Examiner (Ans. 4 and 6) that Cromer's discovery of an incorrect password (i.e., authentication failure) is a failure to communicate. Thus, Cromer discloses disabling the operation of the wireless device 30 upon a failure to communicate the correct password (FF 1; Ans. 6).

Appellant's arguments (App. Br. 10-11; Reply Br. 1-3) that Cromer's failure to provide correct information (i.e., to authenticate) is not a failure to communicate are unpersuasive. A reasonably broad interpretation of the "fails to communicate" language of claim 1 encompasses Cromer's failure to authenticate.

Claims 11 and 20 contain the same limitation as claim 1, using the same language; a "device that fails to communicate with a base station over a range limited wireless protocol" (claims 1, 11, and 20). With regard to the anticipation rejection of claims 2, 4, 7 to 9, 11, 12, 14, 16 to 18, 20, 21, 23, and 26 to 28, Appellant only presents arguments with respect to independent claim 1.

In view of the foregoing, we will sustain the Examiner's anticipation rejection of independent claim 1. For similar reasons, we will also sustain the Examiner's anticipation of (i) claims 2, 4, and 7 to 9 which depend from 1, (ii) independent claims 11 and 20 which are not separately argued and contain similar limitations, and (iii) claims 12, 14, 16 to 18, 21, 23, and 26 to 28 which depend from respective ones of claims 11 and 20.

Second Issue: Availability of Girard as a Prior Art Reference

Appellant states in the Appeal Brief that “the present application and the Girard patent were, at the time the invention was made, owned by Intel Corporation” (App. Br. 12). The Appeal Brief is signed by an attorney of record, and, therefore, the statement as to common ownership at the time the invention was made is alone “sufficient evidence to disqualify [Girard] from being used in a rejection under § 103(a) . . .” (MPEP § 706.02(l)(2)). The Examiner is silent concerning this evidence and any qualification for using Girard under § 103(a). On this record, including the MPEP published practice, we are persuaded by Appellant’s statement as being sufficient evidence to disqualify Girard.

Third Issue: Obviousness Rejection of Claims 3, 13, and 22

Because Cromer is silent as to using Bluetooth technology (*see generally* FF 1 and 2), and because the Examiner relies upon Girard for disclosing the Bluetooth feature recited in claims 3, 13, and 22, we will not sustain the Examiner’s obviousness rejection of claims 3, 13, and 22.

Fourth Issue: Obviousness Rejection of Claims 10, 19, and 29

Even though Girard is not available as prior art under 35 U.S.C. § 103, an obviousness rejection may be affirmed on less than all of the references if all of the claim limitations are found in only one reference.² In the instant case, the limitation common to each of claims 10, 19, and 29 of

² “[A] rejection for obviousness under § 103 can be based on a reference which happens to anticipate the claimed subject matter.” *In re Meyer*, 599 F.2d 1026, 1031 (CCPA 1979). *See also In re Bush*, 296 F.2d 491 (CCPA 1961) (order of references is not important in making an obviousness rejection).

preventing booting of a wireless device when the signal sent from the device is not authenticated by a base station is disclosed or suggested by Cromer alone (*see* FF 2). Specifically, Cromer discloses completing a boot process only when a password has been correctly entered (*see* steps 306, 308, 318, and 326 in Fig. 3A).

Appellant's arguments with regard to the obviousness rejection of claim 10 (App. Br. 11-12; Reply Br. 3), that Cromer and Girard do not relate to claim 10 which requires authentication by a base station before the wireless device can boot, is unconvincing in light of our findings as to Cromer (FF 2).

Accordingly, we will sustain the Examiner's obviousness rejection of claims 10, 19, and 29.

Obviousness Rejection of Claims 5, 15, 24, and 25

Appellant has not disputed the merits of the obviousness rejection of claims 5, 15, 24, and 25, and the Examiner has not withdrawn the obviousness rejection of claims 5, 15, 24, and 25 over Cromer (*see* Ans. 3; Fin. Rej. 7). Accordingly, we will resolve the obviousness rejection of claims 5, 15, 24, and 25 for similar reasons provided *supra* with regard to the anticipation rejection of claims 1, 11, and 20, and because Appellant has failed to rebut the Examiner's prima facie case of obviousness. *See* 37 C.F.R. § 41.37(c)(1)(vii) (requiring a statement in the briefs as to each ground of rejection presented by Appellant for review); 37 C.F.R. § 41.37(c)(1)(vii) (stating that arguments not presented in the briefs by Appellants will be refused consideration).

ORDER

The decision of the Examiner rejecting claims 1, 2, 4, 5, 7 to 12, 14 to 21, and 23 to 29 is affirmed. The decision of the Examiner rejecting claims 3, 13, and 22 is reversed. Accordingly, the decision of the Examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED-IN-PART

KIS

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